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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,141	02/10/2004	George L. KISER JR.	14573.44257	2140
26702	7590	03/11/2005	EXAMINER	
MORRIS, MANNING & MARTIN LLP 6000 FAIRVIEW ROAD SUITE 1125 CHARLOTTE, NC 28210				ESCALANTE, OVIDIO
		ART UNIT		PAPER NUMBER
		2645		

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>  10/708,141	<b>Applicant(s)</b>  KISER ET AL.
<b>Examiner</b>  Ovidio Escalante	<b>Art Unit</b>  2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 10 February 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-88 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-88 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-12,14,17-28,30-39,42,43,52,59-72,75-85 and 88 are rejected under 35 U.S.C. 102(e) as being Zirngibl by US Patent 6,829,334.

***Regarding claim 1***, Zirngibl teaches a method, comprising the steps of:

- (a) offering, to a recipient of voice mail services, a subscription to voice mail messages pertaining to a particular subject matter, (col. 7, lines 8-35); and
- (b) providing to said recipient, pursuant to said offering, a voice mail message pertaining to the particular subject matter, (col. 9, lines 52-63).

***Regarding claim 2***, Zirngibl, teaches a method comprising the steps of:

- (a) identifying recipients of voice mail services who have elected to subscribe to voice mail messages pertaining to a particular subject matter, (col. 4, lines 50-63); and
- (b) providing to said identified recipients a voice mail message pertaining to the particular subject matter, (col. 9, lines 52-63; col. 23, lines 10-15)

***Regarding claim 3***, Zirngibl teaches a method, comprising the steps of:

- (a) offering, to recipients of voice mail services, subscriptions to voice mail messages pertaining to one or more particular subject matters, (col. 7, lines 8-35)

(b) at periodic intervals, (i) identifying those recipients who have elected to subscribe to voice mail messages of said offering, (col. 4, lines 50-63) and (ii) providing to said identified recipients a voice mail message of said offering, (col. 9, lines 52-63; col. 23, lines 10-15).

***Regarding claims 4 and 20***, Zirngibl, as applied to claims 3 and 19, teaches wherein said step of offering includes offering to provide a subscription to voice mail messages pertaining to a single particular subject matter, (col. 7, lines 8-35).

***Regarding claims 5 and 21***, Zirngibl, as applied to claim 3, teaches wherein said step of offering includes offering to provide a subscription to voice mail messages pertaining to a plurality of particular subject matters, (col. 7, lines 8-35).

***Regarding claims 6 and 22***, Zirngibl, as applied to claim 5, teaches, wherein subscription to voice mail messages is offered on a per subject matter basis, (col. 7, lines 8-35).

***Regarding claims 7 and 23***, Zirngibl, as applied to claim 6, teaches charging a subscription fee on a per subject matter basis, (col. 28, lines 45-59).

***Regarding claims 8 and 24***, Zirngibl, as applied to claim 5, teaches receiving, from a particular recipient electing to subscribe to voice mail messages, an identification of a selection of particular subject matters out of the plurality of particular subject matters of said offering, (col. 7, lines 8-35).

***Regarding claims 9-11,25,26,82 and 83***, Zirngibl, as applied to claim 3, teaches wherein said periodic intervals comprises days, weeks and months (col. 11, line 64-col. 12, line 13).

***Regarding claims 12 and 28***, Zirngibl, as applied to claim 3, teaches charging a fee for the subscription to the voice mail messages of said offering, (col. 28, lines 45-59).

***Regarding claims 14,17,52,59,72,75,85 and 88***, Zirngibl, as applied to claim 3, teaches wherein a particular subject matter comprises sports and new topics, (col. 9, lines 52-64).

***Regarding claim 18***, Zirngibl teaches a voice mail message subscription service including a method, (abstract), the method comprising the steps of:

(a) offering to provide (i) voice mail services and, in conjunction therewith, (ii) a subscription to voice mail messages pertaining to one or more particular subject matters, (col. 7, lines 8-35); and

(b) at periodic intervals, (i) identifying recipients of the voice mail services of said offering who, pursuant to said offering, have elected to subscribe to the voice mail messages of said offering, (col. 4, lines 8-35), and (ii) providing to said identified recipients a voice mail message of said offering, (col. 9, lines 52-63; col. 23, lines 10-15).

***Regarding claim 19***, Zirngibl teaches a voice mail message subscription service including a method, (abstract), the method comprising the steps of:

(a) offering to provide, to recipients of voice mail services, subscriptions to voice mail messages pertaining to one or more particular subject matters, (col. 7, lines 8-35); and

(b) at periodic intervals, (i) identifying recipients of the voice mail services who, pursuant to said offering, have elected to subscribe to voice mail messages of said offering, (col. 9, lines 52-63; col. 12, lines 10-15), and (ii) providing to said identified recipients a voice mail message of said offering, (col. 11, line 64-col. 12, line 13).

***Regarding claims 27 and 84***, Zirngibl, teaches wherein said periodic intervals are intermittent, (col. 11, line 64-col. 12, line 13).

***Regarding claim 30***, Zirngibl, as applied to claim 19, teaches wherein said step of providing to said identified recipients a voice mail message of said offering comprises the step of making a voice mail message of said offering accessible for listening by each of said identified recipients, (col. 9, lines 52-63).

***Regarding claim 31***, Zirngibl, as applied to claim 19, teaches wherein said step of providing to said identified recipients a voice mail message of said offering comprises the step of, for each particular one of said identified recipients, playing the same digital audio file that represents said provided voice mail message of said offering, (col. 4, lines 50-63).

***Regarding claim 32***, Zirngibl, as applied to claim 19, teaches wherein said step of providing to said identified recipients a voice mail message of said offering comprises the step of, for each particular said identified recipient, distributing to a voice mail inbox of the particular said identified recipient a digital audio file that represents said provided voice mail message of said offering, (col. 4, lines 50-63; col. 9, lines 52-63).

***Regarding claim 33***, Zirngibl, as applied to claim 19, teaches wherein said step of providing to said identified recipients a voice mail message of said offering comprises the step of, for each particular said identified recipient, copying to a voice mail inbox of the particular said identified recipient a digital audio file that represents said provided voice mail message of said offering, (col. 23, lines 9-15).

***Regarding claim 34***, Zirngibl, as applied to claim 19, teaches wherein a voice mail service provider that provides voice mail services to the recipients also performs the steps of the method, (col. 2, lines 8-23).

***Regarding claim 35***, Zirngibl, as applied to claim 34, teaches wherein said step of providing the voice mail message comprises the steps, by the voice mail service provider, of receiving the voice mail message, and then making the voice mail message accessible through voice mail for recipient listening, (col. 9, lines 52-63).

***Regarding claim 36***, Zirngibl, as applied to claim 34, teaches wherein said provided voice mail message is created by other than the voice mail service provider, (col. 7, lines 8-23).

***Regarding claim 37***, Zirngibl, as applied to claim 34, teaches wherein said provided voice mail message is created by a voice mail message provider, (col. 7, lines 8-35).

***Regarding claim 38***, Zirngibl, as applied to claim 37, teaches wherein said voice mail message provider is different from the voice mail service provider, (fig. 4).

***Regarding claim 39***, Zirngibl, as applied to claim 37, teaches charging a fee for said providing of the voice mail message pertaining to the particular subject matter, (col. 28, lines 45-59).

***Regarding claim 42***, Zirngibl, as applied to claim 19, teaches wherein the provision of a subscription to voice mail messages pertaining to one or more particular subject matters represents an optional add-on service to the voice mail services, (abstract).

***Regarding claim 43***, Zirngibl, as applied to claim 19, teaches creating said provided voice mail message of said offering, (col. 7, lines 8-35).

***Regarding claim 60***, Zirngibl teaches a method of providing audible messages that pertain to one or more particular subject matters to subscribers who have elected to receive the audible messages, (col. 7, lines 8-35), the method comprising the steps of:

- (a) maintaining subscriber specific records, each record including one or more distribution indicators of a respective subscriber, each distribution indicator corresponding to a particular subject matter for which the respective subscriber has elected to receive audible messages, (col. 19, lines 66-col. 20, line 14,39-50);
- (b) creating an audible message pertaining to a certain one of the particular subject matters, (col. 11, lines 51-63);
- (c) associating a distribution indicator with said created audible message, said associated distribution indicator corresponding to the certain one of the particular subject matters, (col. 11, line 64-col. 12, line 8); and
- (d) distributing said created audible message to each subscriber whose record includes the distribution indicator corresponding to said associated distribution indicator of said created audible message, (col. 9, lines 52-63).

***Regarding claim 61***, Zirngibl, as applied to claim 60, teaches wherein each subscriber specific record further includes a destination indicator for the subscriber, (col. 20, line 56 - col. 21, line 11).

***Regarding claim 62***, Zirngibl, as applied to claim 61, teaches wherein a destination indicator comprises a telephone number, (col. 21, lines 5-11).

***Regarding claim 63***, Zirngibl, as applied to claim 62, teaches wherein a destination of the destination indicator comprises a telephone, a telephone answering machine, a voice mail inbox, or a telephone answering service, (col. 20, line 56-col. 21, line 11).

***Regarding claim 64***, Zirngibl, as applied to claim 61, teaches wherein distributing the audible message comprises transmitting the audible message as a telephony signal in real time, (col. 9, line 52-63).

***Regarding claim 65***, Zirngibl, as applied to claim 61, teaches wherein distributing the audible message comprises transmitting the audible message in data packets, (col. 24, lines 17-25).

***Regarding claim 66***, Zirngibl, as applied to claim 61, teaches wherein the audible message comprises a digital audio file, (col. 9, lines 52-63).

***Regarding claim 67***, Zirngibl, as applied to claim 61, teaches wherein a destination indicator comprises an email address, (col. 24, lines 17-25; col. 25, lines 16-23).

***Regarding claim 68***, Zirngibl, as applied to claim 60, teaches wherein distributing the audible message comprises distributing an indication of availability of the audible message, (col. 9, lines 52-63).

***Regarding claim 69***, Zirngibl, as applied to claim 60, teaches prior to the step of distributing the audible message, the step of generating an indication of availability of the audible message, (col. 9, lines 52-63).

***Regarding claim 70***, Zirngibl, as applied to claim 60, teaches receiving from a particular subscriber an election to receive audible messages pertaining to another particular subject matter, and including in the record of the particular subscriber a distribution indicator corresponding to this other particular subject matter, (col. 7, lines 8-35).

***Regarding claim 71***, Zirngibl, as applied to claim 60, teaches receiving from a new subscriber an election to receive audible messages pertaining to a particular subject matter, and

generating a new record for the new subscriber, said generated record including a distribution indicator corresponding to the particular subject matter of the election, (col. 4, lines 50-63).

***Regarding claim 76***, Zirngibl teaches an audible message subscription service, (abstract), including a method comprising the steps of:

- (a) identifying recipients who have elected to subscribe to audible messages pertaining to one or more predefined subject matters, (col. 19, line 60-col. 20, line 14);
- (b) creating an audible message pertaining to a particular one of the predefined subject matters, (col. 11, lines 51-63); and
- (c) providing said created audible message to said identified recipients, (col. 9, lines 52-63).

***Regarding claim 77***, Zirngibl, as applied to claim 76, teaches the step of offering to provide subscriptions to audible messages pertaining to the predefined subject matters, and wherein said identified recipients have elected to subscribe to the audible messages in response to said offering, (col. 7, lines 8-35).

***Regarding claim 78***, Zirngibl, as applied to claim 77, teaches wherein said step of offering includes offering to provide a subscription to audible messages pertaining to a single predefined subject matter, (col. 7, lines 8-35).

***Regarding claim 79***, Zirngibl, as applied to claim 77, teaches wherein said step of offering includes offering to provide a subscription to audible messages pertaining to a plurality of predefined subject matters, (col. 7, lines 8-35).

***Regarding claim 80***, Zirngibl, as applied to claim 79, teaches receiving, from a particular recipient electing to subscribe to audible messages, an identification of a selection of predefined

subject matters out of the plurality of predefined subject matters of said offering, (col. 7, lines 8-35).

***Regarding claim 81***, Zirngibl, as applied to claim 76, teaches repeating steps (b) and (c) at periodic intervals, (col. 11, line 64-col. 12, line 13).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 15,16,44-51,53-58,73,74,86 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zirngibl in view of well known prior art, MPEP 2144.03

***Regarding claims 15,16,44-51,53-58,73,74,86 and 87***, Zirngibl, teaches of providing the user subject based content including but not limited to sports, stock quotes and news. Zirngibl does not specifically teach that the subject matter may comprise a religious topic, political topic or including voice of famous persons, racing topic, fishing topics. However, the Examiner believes that the above claims are only directed to the content of what is being sent and where the only difference between a prior art product and a claimed product is message content/matter that is not functionally related to the product, the content of the message will not distinguish the claimed product for the prior art. *In re Ngai*, 70 USPQ 2d, 1862 (CAFC 2004).

Nonetheless, the Examiner takes Official Notice that changing the content of a voice message to include racing, fishing, political, religious and sports topics was well known in the art and it would have been obvious to one of ordinary skill in the art to change the content of the message to be at least one of the above topic so that the content providers can reach out to more subscribers by having topics that everyone would like to listen to on a periodic basis.

7. Claims 13,29,40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zirngibl in view of Saylor US Patent 6,792,086.

***Regarding claims 13, 29, 40 and 41***, Zirngibl, as applied to claims 3 and 39, teaches of charging a fee for the subscription-based service. Zirngibl teaches that a user is billed based on the voice services provide. Zirngibl does not specifically teach where no fee is charged for the subscriber to the voice mail messages or that the fee is allocated between the voce mail service

provider, voice mail message provider and an organization associated with the particular subject matter.

In the same field of endeavor, Saylor teaches wherein no fee is charged for the subscription to the voice mail messages of said offering, (col. 6, lines 7-20), allocating said charged fee between the voice mail service provider and the voice mail message provider (col. 20, lines 11-33) and allocating said charged fee between the voice mail service provider, the voice mail message provider, and an organization associated with the particular subject matter, (col. 20, lines 11-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the fee based structure of Zirngibl by not charging a fee or by allocation the fee to different entities as taught by Saylor so that user can be encourage to use the service if their was no fee and so that network entities that provide the service can be paid for providing the service if a fee is used.

***Conclusion***

8. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 872-9306, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

220 20<sup>th</sup> Street S.  
Crystal Plaza two, Lobby, Room 1B03  
Arlington, VA 22202

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 703-308-6262 (571-272-7537 After March 22, 2005). The examiner can normally be reached on M-Th from 6:30 to 4:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 703-305-4895 (571-272-7547 After March 22, 2005). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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March 7, 2005

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